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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/797,284
Filing Date: March 10, 2004
Appellant(s): KIRCHHOFF ET AL.

St. Onge, Steward, Johnston and Reens, LLC
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed **20 June 2008** appealing from the Office

action mailed **25 February 2008**.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is incorrect. Applicant summarized claims 1, 7, 36, 49, 69, and 73. However, the arguments focus on claims 1, 7, 36, 48-49, 69, 73 and 74. Claims 48 and 74 were not discussed in the Summary of Claimed Subject Matter section of the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal

contained in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0027164 A1	Mault et al.	03-2002
2002/0027164 A1	Mault et al.	03-2002

Jill barker, "There's a gym on the Job: St. Mary's Hospital

Offers Full-Service Facility for the Use of its Harried Staff",

The Gazette,   03-2000

Applicants Own Admission

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   **Claims 1-5, 7-16, 18-34, 38-42, 44-45, 48-50, 53-54, 57, 59-61, 63-64, 69-71, 74, 76-80** are rejected under 35 U.S.C. 102(e) as being anticipated by **Mault et al. (2002/0027164 A1)** (hereinafter "**Mault–164**").

3.   **With respect to Claim 1: (Original)** Mault-164 teaches a system for facilitating the control of body weight of a person, said system comprising:

- A processor operable to execute software that maintains a meal plan for the person; (See at least Mault-164: Fig. 3, item 31 and other supporting text).

- A memory unit operable to store data associated with the meal plan; (See at least Mault-164: Fig. 3, item 34 and other supporting text); and

- An input/output device operable to provide an interface for the person to operate the software and receive an updated body weight from the person; (See at least Mault-164: Fig. 2 and other supporting text)

- A display operable to present the meal plan to the person, the meal plan being automatically altered by the processor based on the updated body weight. (paragraphs; 57, 87 and 98 - a shopping list is "generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information ... [t]he PDA may suggest complete, nutritionally balanced meals to the person". (paragraph 57); message sent to client advising not to complete meal to

remain on diet program; ""Failure to reach weight goals may be used to modify food orders placed by the PDA").

4.   **With respect to Claim 2: (Original)** Mault-164 teaches:

- A network coupled to the system; (See at least Mault-164: Fig. 4, item 48 and other supporting text) and

- Wherein the input/output unit is operable to communicate the data associated with the meal plan across the network. (See at least Mault-164: Fig. 3 and Fig. 4, as well as other supporting text).

5.   **With respect to Claims 3 and 77: (Original)** Mault-164 teaches the network is the Internet. (See at least Mault-164: Paragraph 59).

6.   **With respect to Claim 4: (Original)**   Mault-164 teaches the software being executed, by the processor is further operable to generate the meal plan based on characteristics associated with the person. (See at least Mault-164: Paragraph 50).

7.   **With respect to Claims 5 and 80:   (Original)** Mault-164 teaches the characteristics include demographics. (See at least Mault-164: Paragraphs 6 and 50).

8.   **With respect to Claim 7: (Original)** Mault-164 teaches a method for facilitating the control of body weight of a person, said method comprising:

- Receiving an initial body weight of the person; (See at least Mault-164: Paragraph 50).

- Determining a target food consumption plan for the person based at least in part on the initial body weight; (See at least Mault-164: Paragraph 57).

- Receiving an updated weight of the person; (See at least Mault-164: Paragraph 98 – inherent from paragraph that to determine weight failure weight value would have to be updated) and

- Automatically altering the target food consumption plan for the person based at least in part on the updated weight of the person. (paragraphs; 57, 87 and 98 - a shopping list is "generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information ... [t]he PDA may suggest complete, nutritionally balanced meals to the person". (paragraph 57); message sent to client advising not to complete meal to remain on diet program; ""Failure to reach weight goals may be used to modify food orders placed by the PDA").

9.   **With respect to Claim 8: (Original)**   Mault-164 teaches determining a target food consumption plan includes:

- Determining a range of values based at least in part on the initial body weight of the person; (See at least Mault-164: Paragraph 57) and

- Selecting food for the person to consume on a daily basis based on the range of values. (See at least Mault-164: Paragraph 57).

10.   **With respect to Claim 9: (Original)**   Mault-164 teaches selecting a meal plan from a predetermined set of foods. (See at least Mault-164: Paragraph 57).

11.   **With respect to Claim 10: (Original)** Mault-164 teaches the predetermined set of foods is composed of a pre-established set of foods and a user supplied set of foods. (See at least Mault-164: Paragraphs 56, 57, 59 and 60).

12.   **With respect to Claim 11: (Original)**   Mault-164 teaches the pre-established set of foods include foods prepared by consumer restaurants. (See at least Mault-164: Paragraph 66).

13.   **With respect to Claim 12: (Original)**   Mault-164 teaches the pre-established set of foods include branded foods. (See at least Mault-164: Paragraph 67).

14.   **With respect to Claim 13: (Original)**   Mault-164 teaches at least some of the predetermined set of foods are meals. (See at least Mault-164: Paragraph 57).

15.   **With respect to Claim 14: (Original)**   Mault-164 teaches communicating a message to the user based on the updated weight of the person. (See at least Mault-164: Paragraph 98 – inherent from paragraph that to determine weight failure weight value would have to be updated).

16.   **With respect to Claim 15: (Original)** Mault-164 teaches the message provides at least one of the following: congratulations, encouragement, suggestions, warnings, and feedback information. (See at least Mault-164: Paragraph 47).

17.   **With respect to Claim 16: (Currently Amended)**   Mault-164 teaches:

- Providing a user selectable indicium operable to be utilized by the person in times of weight control difficulty; (See at least Mault-164: Paragraphs 74 and 75)

- Receiving a notification upon the user selectable indicium being selected by the person; (See at least Mault-164: Paragraphs 74 and 75) and

- Providing the person at least one selectable element associated the underlying information. (See at least Mault-164: Paragraph 75 – customized feedback provided to user).

18. **With respect to Claims 18 and 78: (Original)** Mault-164 teaches at least one selectable element is a hyperlink. (See at least Mault-164: Paragraphs 62 and 74).

19. **With respect to Claim 19: (Original)** Mault-164 teaches receiving at least one of height and age of the person. (See at least Mault-164: Paragraph 50).

20. **With respect to Claims 20 and 40: (Original)** Mault-164 teaches receiving demographical information associated with the person. (See at least Mault-164: Paragraphs 6 and 50).

21. **With respect to Claims 21 and 41: (Original)** Mault-164 teaches altering the target food consumption plan of the person based on the demographical information associated with the person. (See at least Mault-164: Paragraphs 60-61).

22. **With respect to Claim 22: (Original)** Mault-164 teaches the demographical information includes at least one of the following: gender, race, and ethnicity. (See at least Mault-164: Paragraph 50).

23. **With respect to Claim 23: (Original)** Mault-164 teaches determining of the target food consumption plan is further based at least in part on the demographical information associated with person. (See at least Mault-164: Paragraphs 6, 50, and 61).

24. **With respect to Claim 24: (Original)** Mault-164 teaches determining of the target food consumption plan is based on decreasing weight of the person. (See at least

Mault-164: Paragraphs 2, 26, 50 and 57 – diet management can include decreasing weight).

25.   **With respect to Claim 25: (Original)** Mault-164 teaches determining of the target food consumption plan is based on maintaining weight of the person. (See at least Mault-164: Paragraphs 2, 26, 50 and 57 – diet management can include maintaining weight).

26.   **With respect to Claim 26: (Original)** Mault-164 teaches determining of the target food consumption plan is based on increasing weight of the person. (See at least Mault-164: Paragraphs 2, 26, 50 and 57 – diet management can include increasing weight).

27.   **With respect to Claim 27: (Currently Amended)** Mault-164 teaches:

- providing indicium of selectable activities for the person to engage; (See at least Mault-164: Paragraphs 74 and 75) and

- receiving a selection of at least one selectable activity from the user. (See at least Mault-164: Paragraphs 74 and 75).

28.   **With respect to Claims 28 and 44: (Original)** Mault-164 teaches utilizing the selection to alter the amount of consumable food to satisfy the target consumption plan. (See at least Mault-164: Paragraphs 47 and 57).

29.   **With respect to Claim 29: (Original)**   Mault-164 teaches altering the target food consumption plan of the person based on the selection. (See at least Mault-164: Paragraphs 47 and 57).

30.   **With respect to Claim 30: (Original)** Mault-164 teaches automatically altering the target food consumption plan is performed by a computing device. (See at least Mault-164: Paragraphs 47 and 57).

31.   **With respect to Claim 31: (Original)** Mault-164 teaches computing device is a hand-held computing device. (See at least Mault-164: Figs. 1 and 2, as well as accompanying text; Paragraph 39).

32.   **With respect to Claim 32:   (Original)** Mault-164 teaches comprising communicating the altered food consumption plan across a network. (See at least Mault-164: Paragraph 57; Fig. 3, items 37 and 38 and Fig. 4, item 48, as well as accompanying text).

33.   **With respect to Claim 33: (Original)** Mault-164 teaches comprising receiving at least one other characteristic of the person. (See at least Mault-164: Paragraph 50).

34.   **With respect to Claim 34: (Original)** Mault-164 teaches determining of the target food consumption plan for the person is additionally based on the at least one other characteristic. (See at least Mault-164: Paragraphs 50 and 57).

35.   **With respect to Claim 36: (Original)** Mault-164 teaches a system for facilitating the control of body weight of a person, said method comprising:

- Means for receiving an initial body weight of the person; (See at least Mault-164: Paragraph 57; Figs. 1 and 2, as well as accompanying text).

- Means for determining target food consumption plan for the person based at least in part on the initial body weight; (See at least Mault-164: Paragraphs 2, 26, 50 and 57 – diet management can include increasing weight).

- Means for receiving an updated weight of the person; (See at least Mault-164: Paragraph 98 – inherent from paragraph that to determine weight failure weight value would have to be updated) and

- Means for automatically altering the target food consumption plan for the person based at least in part on the updated weight of the person. (paragraphs; 57, 87 and 98 - a shopping list is "generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information ... [t]he PDA may suggest complete, nutritionally balanced meals to the person". (paragraph 57); message sent to client advising not to complete meal to remain on diet program; ""Failure to reach weight goals may be used to modify food orders placed by the PDA").

36.   **With respect to Claim 38: (Original)** Mault-164 teaches means for communicating a message to the user based on the updated weight of the person. (See at least Mault-164: Paragraph 98 – inherent from paragraph that to determine weight failure weight value would have to be updated).

37.   **With respect to Claim 39: (Original)** Mault-164 teaches:

- Means for providing a user selectable indicia operable to be utilized by the person in times of weight control difficulty; (See at least Mault-164: Paragraphs 74 and 75).

- Means for receiving a notification upon the user selectable indicia being selected by the person; (See at least Mault-164: Paragraphs 74 and 75) and

- Means for providing the person at least one selectable element associated with underlying information, suggestions, and commentary. (See at least Mault-164: Paragraph 75 – customized feedback provided to user).

38.   **With respect to Claim 42:   (Original)**   Mault-164 teaches target food consumption plan is further based at least in part on the demographical information associated with person. (See at least Mault-164: Paragraphs 50 and 57).

39.   **With respect to Claim 45: (Original)** Mault-164 teaches means for altering the target food consumption plan of the person based on the selection. (See at least Mault-164: Paragraphs 47 and 57).

40.   **With respect to Claim 48: (Original)** Mault-164 teaches a computer-readable medium having stored thereon sequences of instructions, the sequences of instructions including instructions, when executed by a processor, cause the processor to:

- Receive an initial body weight of the person; (See at least Mault-164: Paragraph 50).

- Determine a target food consumption plan for the person based at least in part on the initial body weight; (See at least Mault-164: Paragraph 57).

- Receive an updated weight of the person; (See at least Mault-164: Paragraph 98 – inherent from paragraph that to determine weight failure weight value would have to be updated) and

- Automatically alter the target food consumption plan for the person based at least in part on the updated weight of the person. (See at least Mault-164:

Paragraph 98 – inherent from paragraph that to determine weight failure weight value would have to be updated).

41.   **With respect to Claim 49: (Currently Amended)**   Mault-164 teaches a method for managing data utilized by an online personalized weight control program, said method comprising:

- Receiving identification of a user; (See at least Mault-164: Paragraph 50).

- Receiving an initial profile representative of characteristics of a user including a weight of the user (See at least Mault-164: Paragraph 50).

- Forming a dataset based on the initial profile associated with the user; the dataset including a meal plan based in part on the weight of the user; (See at least Mault-164: Paragraph 50; Fig. 3, item 36 as well as supporting text; paragraph 98).

- Providing a plurality of interoperable selectable weight control elements for access by the user to personalize the dataset; (See at least Mault-164: Paragraphs 50, 55, 56 and 58).

- Receiving data associated with the weight control elements; including an updated weight of the user (See at least Mault-164: Paragraphs 50 and 98).

- Updating the dataset in accordance with the received data such that the meal plan is altered based in part on the updated weight of the user; (paragraphs; 57, 87 and 98 - a shopping list is "generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information ... [t]he PDA may suggest complete,

> nutritionally balanced meals to the person". (paragraph 57); message sent to client advising not to complete meal to remain on diet program; ""Failure to reach weight goals may be used to modify food orders placed by the PDA") and

- Storing the updated dataset, the updated dataset being utilized by the user to follow a personalized weight control program. (See at least Mault-164: Paragraph 51).

42. **With respect to Claims 50: (Original)** Mault-164 teaches the interoperable selectable weight control elements include at least one of food and exercise items. (See at least Mault-164: Paragraphs 57 and 74).

43. **With respect to Claim 53: (Original)** Mault-164 teaches updating is performed automatically. (See at least Mault-164: Paragraph 98 – inherent from paragraph that to determine weight failure weight value would have to be updated).

44. **With respect to Claims 54: (Original)** Mault-164 teaches the interoperable selectable weight control elements include a journal interface operable to provide a daily listing of foods for consumption in accordance with the personalized weight control program. (See at least Mault-164: Paragraph 86).

45. **With respect to Claim 57: (Original)** Mault-164 teaches the target value is a maximum number of values as a function of food consumption and activities allotted by the weight control program. (See at least Mault-164: Paragraphs 57 and 74).

46.   **With respect to Claim 59: (Original)** Mault-164 teaches updating of the dataset is performed by a computing device in communication with a network. (See at least Mault-164: Fig. 3, items 37 and 38 and Fig. 4, item 48, as well as accompanying text).

47.   **With respect to Claims 60 – 68: (Cancelled)**

48.   **With respect to Claim 69: (Original)** Mault-164 teaches a system for facilitating control of body weight of a person, said system comprising:

- A computing device operable to execute a software program having a plurality of software elements operable to facilitate control of body weight of the person, the software elements operable to facilitate control of body weight of the person utilizing at least two sources of input, (See at least Mault-164: Figs. 1 and 2, as well as accompanying text; Paragraph 39).

- A first input source being a planned set of food items to be consumed based on a current weight of the person and a second input source being an actual set of food items consumed by the person, (See at least Mault-164: Paragraphs 47, 55 and 57).

- The software elements further operable to receive updated weight of the person to alter the planned set of food items for future food item consumption. (paragraphs; 57, 87 and 98 - a shopping list is "generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information ... [t]he PDA may suggest complete, nutritionally balanced meals to the person". (paragraph 57); message sent to client advising not to complete meal to remain on diet

program; ""Failure to reach weight goals may be used to modify food orders

placed by the PDA").

49.   **With respect to Claim 70: (Original)** Mault-164 teaches the software elements

are further operable to facilitate control of body weight of the person utilizing a third

source of input being actual activities performed by the person. (See at least Mault-164:

Paragraphs 57, 74 and 75).

50.   **With respect to Claim 71: (Original)** Mault-164 teaches one software element

is a journal operable to maintain information associated with the input sources. (See at

least Mault-164: Paragraph 86).

51.   **With respect to Claim 74: (Original)** Mault-164 teaches the input/output device

is further operable to receive an updated body weight from the person, and wherein the

meal plan is automatically altered by the processor based on the updated body weight.

(See at least Mault-164: Paragraph 98 – inherent from paragraph that to determine

weight failure weight value would have to be updated; "failure to reach weight goals may

be used to modify food orders placed by PDA).

52.   **With respect to Claim 76: (Original)** Mault-164 teaches a network coupled to

the system, and wherein the input/output unit is operable to communicate the data

associated with the meal plan across the network. (See at least Mault-164: Fig. 3, items

37 and 38 and Fig. 4, item 48, as well as other supporting text).

53.   **With respect to Claim 79: (Original)** Mault-164 teaches the software being

executed by the–processor is further–operable to generate the meal plan based on

characteristics associated with the person. (See at least Mault-164: Paragraph 57).

Claim Rejections - 35 USC § 103

54.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

55.   **Claims 6, 35, 37, 43, 46-47, 52, 55-56, 58, 72, 73 and 75** are rejected under 35

U.S.C. 103(a) as being unpatentable over **Mault-164** in view of **Mault (2002/0062069**

A1) (hereinafter "**Mault–069**").

56.   **With respect to Claims 6, 35, 47 and 75: (Original)** Mault-164 discloses the

limitations as shown in the rejections above. Mault-164 does not teach the display

periodically or from time to time presents to the person a reminder to enter the updated

body weight.

    However, Mault-069 discloses the display periodically or from time to time

presents to the person a reminder to enter the updated body weight. (See at least

Mault-069: Paragraph 20 – to re-determine their RMR level a client would have to

update their body weight information).

    It would have been obvious to one of ordinary skill in the art at the time of the

invention to remind the client to update body weight information because of the

motivation to "revise the parameters of the program in a manner consistent with a

successful outcome." (See Mault-069: Paragraph 20).

57.   **With respect to Claim 37: (Original)** Mault-164 discloses the limitations as shown in the rejections above. Mault-164 does not teach means for selecting a meal plan from a predetermined set of foods.

However, Mault-069 teaches means for selecting a meal plan from a predetermined set of foods. (See at least Mault-069: Paragraph 99).

It would have been obvious to one of ordinary skill in the art at the time of the invention to select a meal plan from predetermined food because of the motivation of having "information such as nutritional value of the selected meal, [including] caloric, fat and vitamin analysis." (See Mault-069: Paragraph 99).

58.   **With respect to Claim 43: (Original)** Mault-164 discloses means for receiving a selection of at least one selectable activity from the user. (See at least Mault-164: Fig. 4, item 45 as well as supporting text; paragraphs 74 and 75). Mault-164 does not:

- Means for providing indicia of selectable activities for the person to engage;
  However, Mault-069 teaches:
- Means for providing indicia of selectable activities for the person to engage;
  (See at least Mault-069: Paragraph 59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide allow person to select activities they want to engage in via a weight control device because of the motivation to relate "activities to caloric expenditure." (See Mault-069: Paragraph 59).

59.   **With respect to Claim 46: (Original)** Mault-164 discloses the limitations as shown in the rejections above. Mault-164 does not teach means for receiving at least

one other characteristic of the person, said means for determining the target food consumption plan further basing the target food consumption plan on the at least one other characteristic.

Mault-069 however, discloses means for receiving at least one other characteristic of the person, said means for determining the target food consumption plan further basing the target food consumption plan on the at least one other characteristic. (See at least Mault-069: Paragraphs 53 and 55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to receive information on the person determine target food consumption plan because of the motivation to allow "the user to view a breakdown of their daily caloric intake." See Mault-069: Paragraph 55).

60.   **With respect to Claim 52: (Original)** Mault-164 discloses the limitations as shown in the rejections above.   Mault-164 does not teach the dataset includes predetermined meals each having a total food value associated therewith.

Mault-069 however, discloses the dataset includes predetermined meals each having a total food value associated therewith. (See at least Mault-069: Paragraph 99).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have a predetermined meal with total food value because of the motivation of having "information such as nutritional value of the selected meal, [including] caloric, fat and vitamin analysis." (See Mault-069: Paragraph 99).

61.   **With respect to Claim 55: (Currently Amended)** Mault-164 discloses the limitations as shown in the rejections above. Mault-164 does not teach the foods are alterable to establish a different daily listing of foods for consumption.

Mault-069 however, discloses the foods are alterable to establish a different daily listing of foods for consumption. (See at least Mault-069: Paragraphs 54 and 55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have different daily food listings because of the motivation to a varied selection of foods to "assist the user in achieving a weight loss goal." (See Mault-069: Paragraph 54).

62.   **With respect to Claim 56: (Original)** Mault-164 discloses the limitations as shown in the rejections above. Mault-164 does not teach crediting future daily listings based on a total food value of the daily listing being below a target value.

Mault-069 however, discloses crediting future daily listings based on a total food value of the daily listing being below a target value. (See at least Mault-069: Paragraphs 54 and 60; Figs. 6 and 11B as well as supporting text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to credit future daily listings because a daily value may be below target value because of the motivation to revise goals. (See Mault-069: Figure 6).

63.   **With respect to Claim 58: (Original)** Mault-164 discloses the limitations as shown in the rejections above. Mault-164 does not teach crediting is performed for a predetermined number of days.

Mault-069 however, discloses crediting is performed for a predetermined number of days. (See at least Mault-069: Figs. 6 and 11B as well as supporting text; Paragraphs 54, 55, 60 and 62).

It would have been obvious to one of ordinary skill in the art at the time of the invention to give credit for a predetermined number of days because of the motivation to compare progress made towards target goals with initial projections. (See Mault-069: Paragraph 55).

64.   **With respect to Claim 72: (Original)** Mault-164 discloses the limitations as shown in the rejections above. Mault-164 does not teach the software elements are operable to compute a food consumption value to be consumed based on food values associated with the actual food items consumed by the person.

Mault-069 however, discloses the software elements are operable to compute a food consumption value to be consumed based on food values associated with the actual food items consumed by the person. (See at least Mault-069: Figs. 9, 10, 11A 11B as well as supporting text; Paragraphs 53 and 55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to be able to compute food values based on the actual food consumed because of the motivation to provide advice on future diet planning. (See Mault-069: Paragraph 54)

65.   **With respect to Claim 73: (Currently Amended)**Mault-164 teaches:

- A processor operable to execute software that maintains a meal plan for the person; (See at least Mault-164: Paragraph 57).

- A memory unit operable to store data associated with the meal plan; (See at least Mault-164: Fig. 3, item 34 and other supporting text).

- An input/output device operable to provide an interface for the person to operate the software; (See at least Mault-164: Figs. 1 and 2, as well as accompanying text; Paragraph 39)

Mault-164 does not teach . However, Mault-069 teaches

- A display operable to present the meal plan to the person, the meal plan being displayed in a multi-day format and including a user selectable indicium operable to be utilized by the person in order to display the meal plan for a particular one of the days displayed in the multi-day format. (See at least Mault-069: Figs. 11A, 11B and Fig. 20 – diet information can be displayed for the day or the week).

One of ordinary skill in the art would understand that Mault-164 relates to a weight management system. This system provides monitoring of consumption allowing a client to enter information into a diet log and personal information into the system regarding their weight, age, gender and other factors. Clients are provided a shopping list which is "generated automatically based on some or all of the following: usual purchase habits, dietary needs, previous purchase information, diet log information…[t]he PDA may suggest complete, nutritionally balanced meals to the person". (paragraph 57). Mault-069 provides diet information in the form of caloric intake and meal information. This information can be displayed on the basis of a day or week.

Furthermore according to Applicant's own arguments "it is known that PDAs provide a calendar for scheduling personal appointments".(Arguments: page 17) Therefore, Examiner notes that if the PDA can be used to enter appointments it can also be used to enter appointments to both eat a meal and list what type of foods should be in that meal.

66.   **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mault-164** in view of **Jill Barker, "There's a gym on the Job: St. Mary's Hospital Offers Full-Service Facility for the Use of its Harried Staff",** The Gazette, March 28, 2000 (hereinafter "**Barker**").

67.   **With respect to Claim 17: (Currently Amended)**   Mault-164 discloses the limitations as shown in the rejections above.   Mault-164 does not teach the user selectable indicium is a Panic button.

Mault-069 however, discloses the user selectable indicium is a Panic button. (Barker: Page 1, full text, paragraph 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have a panic button as part of a weight control device because of the motivation to help "anyone who is injured of feels sick while exercising." (Barker: Page 1, full text, paragraph 4).

68.   **Claims 51** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mault-164** in view of **Applicants Own Admission**.

69.   **With respect to Claim 51 and 62:** Mault-164 discloses the limitations as shown

in the rejections above. Mault-164 does not teach forming of the dataset is a function of

a predetermined set of rules operable to control weight.

Mault-069 however, discloses forming of the dataset is a function of a

predetermined set of rules operable to control weight. (Background: Page 2, paragraph

5).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have a predetermined set of rules to help control weight because of the

motivation to "define the specific foods, times to eat and exercises to be performed."

(Background: Page 2, paragraph 5).

(10) Response to Argument

Issue 1: Claims 1, 7, 36, 48-49, 69 and 74

In regards to the claims noted above, Appellant argues "nowhere is the concept

that a food plan (based on a user's weight) is altered based on an updated weight of the

user disclosed or taught".   However Examiner asserts that the concept mentioned is

detailed in Mault-164.

Not only is weight information pre-stored but this information can be updated as

well. Mault-164 teaches, "Failure to reach weight goals may be used to modify food

orders placed by the PDA". (paragraph 98)

Toro Co. v. Deere & Co., 355 F.3d 1313, 1320, 69 USPQ2d 1584, 1590 (Fed. Cir. 2004) ("[T]he fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention.") It is inherent within this reference that the only way to know that weight goals have not been met is to have updated weight information. The introduction of new weight information will inform the system that the food order has to be changed to reflect the change in the user's weight.

Mault-164 also teaches that the weight of the user is an essential part of the system utilized. Paragraphs 5 and 26 discuss the measurement of resting energy expenditure which utilizes weight value in its calculation. Accordingly, "the diet management is a part of a weight control program in which the total energy expenditure by the user is measured, and the computed nutritional content of the food consumed by the user is determined." (paragraph 26) Furthermore, Mault-164 details a database 36 which contains pre-stored personal health information which serves the purpose of "guid[ing] the user in consuming the food items and/or preparing the reorder list" (paragraph 45)

As a result, the shopping list is based on the individual's health information and both sets of information are stored in the database. (paragraph 47) Personal data regarding individual is noted as "age, gender, health problems, height, weight, and other factors". (paragraph 50) Furthermore, based on this information "[t]he PDA may suggest complete, nutritionally balanced meals to the person." (paragraph 57) The shopping list

based on current information in the system, such as dietary needs and diet log information is automatically generated. (paragraph 57)

Furthermore, the claims as written have information listed throughout such as claims 10-13-"pre-determined set of foods composed of a pre-established set of foods"; and claim 22–"demographical information includes…gender, race and ethnicity" which can be considered non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that this data adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

In regards to the rejection of claim 74, the rejection being placed under the 35 U.S.C. 102(e) heading is a typographical error. It should be considered rejected under 35 U.S.C. 103(a) like independent claim 73. Furthermore, claim 74 merely claims information and which is non-functional descriptive data. Claim 73 disclose an input/output device operable to provide an interface and claim 74 states that this device receives updated information from the user.

Issue 2: Claim 73

Appellant argues that the there is inadequate basis for combining the teachings of Mault-164 a portable system for providing a weight management service to customers that monitors what they eat and how much they weigh; with the teachings of Mault-069 which promotes health management by providing a meal log, exercise information and also considers monitoring weight an integral part of the system to reject the current application that claims a weight control system with meal plan and journal. If

Applicant claims a journal system it would be obvious that this system is portable as in

Mault-164 so that clients who are probably at work, the gym or out at a restaurant with

friends can enter information within the system. Mault-164 provides a portable weight

management system that enables a client to manage their weight through out the day.

Issues 3 and 4: Claims 17 and 51

In regards to the claims noted above, Appellant argues "nowhere is the concept

that a food plan (based on a user's weight) is altered based on an updated weight of the

user disclosed or taught". However Examiner asserts that the concept mentioned is

detailed in Mault-164.

Not only is weight information pre-stored but this information can be updated as

well. Mault-164 teaches, "Failure to reach weight goals may be used to modify food

orders placed by the PDA". (paragraph 98)

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inherent within this reference that the only way to know that weight goals have not been

met is to have updated weight information. The introduction of new weight information

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Mault-164 also teaches that the weight of the user is an essential part of the system utilized. Paragraphs 5 and 26 discuss the measurement of resting energy expenditure which utilizes weight value in its calculation. Accordingly, "the diet management is a part of a weight control program in which the total energy expenditure by the user is measured, and the computed nutritional content of the food consumed by the user is determined." (paragraph 26) Furthermore, Mault-164 details a database 36 which contains pre-stored personal health information which serves the purpose of "guid[ing] the user in consuming the food items and/or preparing the reorder list" (paragraph 45)

As a result, the shopping list is based on the individual's health information and both sets of information are stored in the database. (paragraph 47) Personal data regarding individual is noted as "age, gender, health problems, height, weight, and other factors". (paragraph 50) Furthermore, based on this information "[t]he PDA may suggest complete, nutritionally balanced meals to the person." (paragraph 57) The shopping list based on current information in the system, such as dietary needs and diet log information is automatically generated. (paragraph 57)

Furthermore, the claims as written have information listed throughout such as claims 10-13-"pre-determined set of foods composed of a pre-established set of foods"; and claim 22-"demographical information includes...gender, race and ethnicity" which can be considered non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given

patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack,* 703 F.2d at 1384-85,217 USPQ at 403; *see also Diamond v. Diehr,* 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry,* 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai,* 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that this data adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the related Appeals and Interferences section of this Examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/H. R./
Examiner, Art Unit 3689

Conferees:

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

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Appeals Conference Specialist